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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,480	07/21/2003	Jean-Christophe Simon	032487-005	4520
<div>7590 10/09/2007 BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404</div>			<div>EXAMINER YU, GINA C</div>	
			<div>ART UNIT 1617</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 10/09/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/622,480

Applicant(s)

SIMON ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/20/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-9,16,17,19,21-25,27-48 and 56-90 is/are pending in the application.
- 4a) Of the above claim(s) 56-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-9,16,17,19,21-25,27-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 20, 2007 has been entered.

Election/Restrictions

Newly submitted claims 56-90 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 56-90 are directed to methods of using compositions, which have been withdrawn in response a written restriction requirement dated February 7, 2006.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 56-90 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 6-9, 16, 17, 19, 21-25, 27, 28, 30, 33-41, 43-45, 47 are rejected under 35 U.S.C. 102(a) as being anticipated by Oko et al. (WO 01/51015).

Okos teaches cosmetic make-up products comprising two different types of interference pigments, which create shadow effects which creates more depth and dimensional appearances at various angles of viewing See p. 3, line 16 – col. 5, line 22. The reference teaches that its lip products, for example, create plump appearance on the lip surface, See p. 5, bridging par. The reference teaches adding about 1-20 % of shadow interference pigment, about 1-20 % of traditional interference pigment, and less than about 5 % of traditional pigments in a standard wax lipstick base. See example 1, illustrating a lipstick composition containing castor oil, caprylic/capric triglyceride, and polydecene, which meet the refractive index limitation as defined by applicants' disclosure, and iron oxide, which meets instant claims 40, 41. See claims 16, 17, 27, 28, 33-39, 43, 45, The reference teaches that its preferred shadow pigment is a platelet comprising a core of mica, with a first outer layer of iron oxide, a second outer layer of transparent silica, which meets the glass substrate limitation of instant claim 1 (b), and an outermost layer of titanium dioxide and iron oxide, which meets the limitation, "at least partially coated with at least one layer of at least one metallic compound" of the same claim. Since the prior art shadow pigments in combination of the multilayered interference pigments produce the same 'volumizing effect' as claimed in the instant claims, it is viewed that the prior art pigments inherently have the particle size limitation of the instant claims 23 – 25. Applying the invention to make a

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foundation, gloss, bronzer is taught. See p. 5, lines 16 – 23. See instant claims 43-45, 47.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 31, 32, 46, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oko as applied to claims 1, 6-9, 16, 17, 19, 21-25, 27, 28, 30, 33-41, 43-45, 47 as above, and further in view of Simon (FR 2777178).

Oko is relied upon as discussed above. While Oko teaches micas layered with about 50-500 nm films of TiO₂, Fe₂O₃, or Cr₃O₃, or combinations thereof, further coated or uncoated with silica, the reference does not specifically mention As for the interference pigments having the structure of instant claims.

Simon teaches cosmetic compositions comprising goniochromatic coloring agents in admixture with up to 20 % of nacreous pigments such as mica coated with titanium dioxide or with iron oxide. See English equivalent, US 6451294 B1, col. 5, lines 41 – 65. See instant claims 1, 40, 41. As for the goniochoromatic coloring agents, liquid crystal colorants and multilayer structured colorants, such as Al/SiO₂/Al/SiO₂/Al and Fe₂O₃/SiO₃/Al/SiO₂/Fe₂O₃, are taught. See col. 3, line 49 – col. 5, line 13. See instant claims 30-32. The reference also teaches the amount of which goniochromatic or monochromic pigment is used. See col. 5, lines 34-40. See instant claims 26-28, 33, 34, 35. Simon also teaches using the interference pigments in making lip-gloss paste,

lipstick, nail varnish, foundation, and mascara. See col. 8, lines 49 – 67; instant claims 44 – 48.

It is obvious that one of ordinary skill in the art would have been motivated to modify the teachings of Oko by substituting the traditional interference pigments with the goniochromatic coloring agents of Simon, because 1) both references are directed to cosmetic composition which utilizes a combination of interference and reflective pigments; and 2) Simon teaches functionally equivalent multilayer interference pigments which provide different colors depending on the thickness of the various layers. Since both of the references teaches making similar cosmetic products, the skilled artisan would have had a reasonable expectation of successfully producing stable cosmetic compositions with shadow effects with desired end colors.

Claims 1, 6-9, 16, 17, 19, 27-29, 33-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (US 6759052 B1) in view of applicants' own disclosure and Blin et al. (FR 2816830).

Suzuki teaches using 4 % of titanium-dioxide coated glass flake in a lip-gloss composition comprising a lipophilic carrier, which is a mixture of polybutene and silicon oil. See instant claims 1, 27-29, 43, 44-46. The terms 'foundation' and 'mascara' refer to the intended use of the composition, thus no patentable weights are given to these terms. See instant claims 47 and 48. Suzuki uses hydrocarbon oils, paraffins, silicone oils, etc. The limitation of instant claims 36-39 are met since applicants' disclosure provides that these oils are useful to be liquid gloss and reflective index of between 1.47-1.51. See applicants' specification, p. [00113]-[00121].

Suzuki fails to teach using another light-reflecting pigment (goniochromatic pigment of instant claim).

Blin et al. teach using flat fibers in cosmetic composition with continuous lipophilic phase. See English equivalents, US 2004/0076649 A1, [0008-0012]. See instant claim 33-35, 42, 43, and 46. The reference teaches that the cosmetic compositions include lip products which are colored, or top coat products, to modify keratinous materials which already have make up compositions applied. The reference teaches that the incorporation of flat fibers into the composition can be done very easily, without losing the cosmetic properties of the composition, while forming a deposit exhibiting a velvety feel to the touch due to the homogeneous dispersion of the flat fibers in the composition. The deposit of the composition provides good feel and mechanical resistance, a bright visual effect when formulated in a translucent carrier. The suitable oil carrier includes cyclic silicone oils and hydrocarbon oils such as paraffin oils. See [0066]. The reference also teaches adding to the top composition preferably 0.02-20 % by weight of additional pigments selected from pearlescent agents, such as mica coated with titanium oxide or iron oxide. See [00127]. See instant claims 1, 6-11, 16, 17, 29, 40, 41. The flat fibers have length of 1-10 microns. See [0027]; See instant claims 27, 28.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the composition of Suzuki by incorporating the flat fibers of Blin, as motivated by the latter reference, because both references teaches the application of the respective inventions in lip products and those products are applied

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over a already made-up skin or lips, and the lip-gloss of the Suzuki reference is oil-based; and Blin teaches the advantages of incorporating the flat fibers in oil-based cosmetic compositions, which include bright visual effect, good feel and mechanical resistance. The skilled artisan would have had a reasonable expectation of successfully producing a stable lip-gloss composition comprising flat fibers with enhanced shine and feel.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 6-9, 16, 17, 19, 21-25, 27-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 66-73, 111-124, 143, 144 of copending Application No. 10/432329 in view of Suzuki.

The '329 claims are directed to compositions comprising interference pigment and one additional pigments such as pearlescent such as mica coated with metal oxides. See '329, claim 121; instant claims 5-11. The interference pigments of the '329 application are polymeric fibers, which are also claimed in the instant application, claim 42. The interferential particles of the copending applications, claims 112 is also claimed in instant claim 31 and 32. See also overlapping weight amount of the pigments in '329, claims 113-115 and instant claims 33-35.

While the '329 invention does not claim the reflective particle of the instant claims, Suzuki teaches that using titanium dioxide coated glass flake to make a lip-gloss is well known in the art. See Suzuki, Example 11.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to modify the claimed invention of '329 by incorporating titanium dioxide coated glass flake to make a lip gloss composition because both '329 and Suzuki inventions are directed to lip products and Suzuki teaches a specific formulation of such product. The skilled artisan would have had a reasonable expectation of successfully producing a stable lip-gloss composition with monochromic color effects.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments with respect to claims 1, 6-11, 15-20, 26-29, 33-35, 40-42, 46 have been considered but are moot in view of the new ground(s) of rejection in part, and not persuasive in part.

Applicants assert that the cited prior arts do not teach or suggest the presently claimed invention, as there is no specific mention in the prior arts to create 'volumizing effect'. Applicants also point out that Simon is directed to a makeup kit of two separate compositions without mixing goniochromatic colorant and additional coloring agents. In response, examiner respectfully points out that such embodiment is a preferred embodiment, and the idea of obtaining a special visual effect by combining two different colorants, with at least one of the colorants being a goniochromatic colorant, is clearly taught by this reference. See Simon, US 6451294, col. 2, lines 55 – 64. Applicants' arguments are unpersuasive particularly because the claimed invention is not limited to any particular colors or the shade of the pigments that are combined to create the 'volumizing effect'.

As correctly pointed out by applicants, Ramin teaches that the metal-coated glass particles give sparkling metallic appearance. However, having the teaching of Simon, which teaches to obtain a viewing angle dependent iridescence effects by the combining the goniochromatic colorant and another sparkling particles, such as mica coated titanium dioxide, the skilled artisan would have had a motivation to replace the mica coated titanium dioxide with the Ramin component due to the specific advantages of the latter invention. Ramin teaches that its particles are more preferable over mica titanium dioxide, although they are used for the same purposes, in that they have better resistance to wear, impact, rubbing, and abrasion. The prior art teaches an independent motivation to arrive to the claimed invention, and the fact that applicant has recognized another advantage which would flow naturally from following the suggestion

of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Similarly, the combined teachings of the Suzuki/Blin references also provide a motivation which is different from what applicants had in making the present composition. The flat fibers of the Blin reference are said to have good feel and mechanical resistance, a bright visual effect when formulated in a translucent carrier. Applicants' remarks that Example 11 of Suzuki only incidentally contains metal coated glass particles are not persuasive, since a specific formulation itself is a strong disclosure and guidance which would have motivated a routineer to make the product.

While applicants refer to the resulting visual effects of combining the two prior art colorants as a synergistic 'volumizing effect', examiner views that this property is a property that results by combining the prior arts as taught by the references. Simon already teaches the iridescence property will depend on the viewing angle when its goniochromatic colorants are combined with another type of shiny particles, and Ramin teaches a specific motivation to use the prior art applicant's glass-coated metal oxide.

With respect to the obviousness double patenting, the rejection is maintained for the reasons of the record.

Conclusion

No claims are allowed.

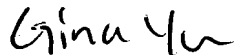
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605.

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The examiner can normally be reached on Monday through Friday, from 8:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gina C. Yu
Patent Examiner